

### **REMARKS**

Applicant hereby traverses the current rejections, and requests reconsideration and withdrawal in light of the amendments and remarks contained herein. Claim 34 stands withdrawn from consideration. Claims 26 and 29-39 are pending in this application.

### **Objection to the Claims**

Claim 36 is objected to for informalities listed on page 3 of the Office Action.

In response, Applicant has amended claim 36 in accordance with the suggestions provided on page 3 of the Office Action. Thus, each identified instance of informality has been corrected with a corresponding amendment. Claim 36 has been amended only for the purpose of resolving the cited informality, and not for the purpose of narrowing its scope in the face of prior art. No new matter has been entered. As this amendment addresses the recited informality, Applicant respectfully requests the withdrawal of the objection of record.

### **Rejection Under 35 U.S.C. § 112**

Claim 38 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the words “the i/o port” and “the memory” in claim 38 are asserted by the Office Action as lacking antecedent basis.

In response, Applicant has amended claim 38 to depend from claim 37. Claim 37 provides antecedent basis for the words “the i/o port” and “the memory”. The claims have been amended only for the purpose of complying with the requirements of 35 U.S.C. § 112, second paragraph, and not for the purpose of narrowing their scope in the face of prior art. No new matter has been entered. As each element of indefiniteness cited by the Office Action has been addressed with a corresponding amendment, Applicant respectfully requests the rejection of claim 38 under 35 U.S.C. § 112, second paragraph be withdrawn.

**Rejection Under 35 U.S.C. § 102**

Claims 26, 29, and 35-36 are rejected under 35 U.S.C. § 102(b) as being anticipated by Millot et al. (US '853, hereinafter Millot).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy at least one of these requirements.

Claim 29, as amended, defines a device for treating tissue, and includes a control unit for passing alternating current to the treatment area via the electrodes and for constantly varying the amplitude and/or the frequency of the alternating current. Millot does not disclose at least these limitations. More specifically, Millot does not disclose passing alternating current to the treatment area. Millot appears to be using direct current, which is different from the claimed alternating current, see column 5, lines 19-37 of Millot. The text of Millot cited by the Office Action, namely column 2, lines 26-29, 42-46, and 48-54, and 58-65; column 3, lines 46-57; column 4, lines 22-45; and column 5, lines 19-37; also do not disclose alternating current in any manner. Furthermore, Millot does not disclose constantly varying either the amplitude or frequency of the alternating current. Millot is silent as to any variation of the either the amplitude or the frequency of the alternating current, as well as being silent to constant variation of the amplitude or the frequency of the alternating current. Thus, Millot does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 29 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 26 and 35-36 depend from base claim 29, and thus inherit all limitations of claim 29. Each of claims 26 and 35-36 sets forth features and limitations not recited by Millot. Thus, the Applicant respectfully asserts that for the above reasons claims 26 and 35-36 are patentable over the 35 U.S.C. § 102 rejection of record.

Furthermore, claim 36 defines that the electronic circuitry of the device stores at least one programme for determining the amplitude, frequency and waveform of alternating current supplied to the electrodes. As Millot is silent as to alternative current, Millot cannot disclose a programme for determining the amplitude, frequency and waveform of the alternating current. Thus, Millot does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 36 is patentable over the 35 U.S.C. § 102 rejection of record.

### **Rejection Under 35 U.S.C. § 102**

Claims 26, 29-30, 32-33, 35, and 39 are rejected under 35 U.S.C. § 102(b) as being anticipated by Claude (US '742).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim," see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy at least one of these requirements.

Claim 29, as amended, defines a device for treating tissue, and includes a control unit for passing alternating current to the treatment area via the electrodes and for constantly varying the amplitude and/or the frequency of the alternating current. Claude does not disclose at least these

limitations. More specifically, Claude does not disclose that the control unit varies constantly the amplitude and/or the frequency of the alternating current. In fact, the amplitude and frequency of Claude cannot be varied. Claude does discuss selecting an amplitude and frequency from particular ranges, but once selected, the amplitude and frequency are fixed and cannot be changed. See column 4, lines 14-17, wherein the characteristics are determined by the values of R2, R3, and C1, in accordance with the manufacturer's specifications. Consequently, Claude is silent as to any variation of either the amplitude or the frequency of the alternating current, as well as being silent as to constant variation of the amplitude or the frequency of the alternating current. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 29 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 30, 32-33, 35, and 39 depend from base claim 29, and thus inherit all limitations of claim 29. Each of claims 30, 32-33, 35, and 39 sets forth features and limitations not recited by Claude. Thus, the Applicant respectfully asserts that for the above reasons claims 30, 32-33, 35, and 39 are patentable over the 35 U.S.C. § 102 rejection of record.

Furthermore, claim 30 defines a device that has the alternating current varying between 50 and 500 microamps. As Claude is silent as to varying the amplitude or frequency of the alternating current, Claude cannot disclose varying the current in the claimed range. Claude does disclose selecting a current, but does not disclose varying the current in the claimed range. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 30 is patentable over the 35 U.S.C. § 102 rejection of record.

Still furthermore, claim 32 defines a device that has the time period between each variation of amplitude and/or frequency be 0.1s. As Claude is silent as to varying the amplitude or frequency of the alternating current, Claude cannot disclose having the time period between variations be at the claimed value. Claude does disclose having a particular frequency, but this does not disclose having the variations occur at the claimed value. Thus, Claude does not teach

all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 32 is patentable over the 35 U.S.C. § 102 rejection of record.

Still furthermore, claim 33 defines a device that has the alternating current having a ramp waveform. The Office Action cites Figure 5 of Claude as teaching a ramp waveform. However, as shown, the waveform is not a ramp but rather is a series of pulses, where the current moves from 0 to the selected value instantaneously. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 33 is patentable over the 35 U.S.C. § 102 rejection of record.

### **Rejection Under 35 U.S.C. § 103**

Claim 31 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Claude.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be shown by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combination fails to teach multiple claim limitations as asserted by the Office Action, Applicant respectfully submits that the present rejections are improper.

Base claim 29 is defined as described above. Claude does not teach all limitations of claim 29 as described above. The modification introduced with respect to claim 31 does not overcome the deficiency in teaching all of the limitations of claim 29. Therefore, the modification of Claude does not teach all elements of the claimed invention of claim 29.

Claim 31 depends from base claim 29, and thus inherit all limitations of claim 29. Claim 31 sets forth features and limitations not recited by the modification of Claude. Thus, the Applicant respectfully asserts that for the above reasons claim 31 is patentable over the 35 U.S.C. § 103(a) rejection of record.

Furthermore, claim 31 defines a device that has the frequency of the alternating current varying between 10 and 900 hertz. As Claude is silent as to varying the amplitude or frequency

of the alternative current, Claude cannot disclose varying the frequency in the claimed range. Claude does disclose selecting a frequency, but does not disclose varying the frequency in the claimed range. Thus, Claude does not teach all of the claimed limitations. Therefore, the Applicant respectfully asserts that for the above reasons claim 31 is patentable over the 35 U.S.C. § 103 rejection of record.

### **Rejections Under 35 U.S.C. § 103**

Claims 37-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot in view of Jacobsen (US '957).

Claim 39 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Millot in view of Claude.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be shown by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the proposed combinations fail to teach multiple claim limitations as asserted by the Office Action, Applicant respectfully submits that the present rejections are improper.

Base claim 29 is defined as described above. Millot does not teach all limitations of claim 29 as described above. The combinations of Millot and Jacobsen, and Millot and Claude introduced with respect to claims 37-39 do not overcome the deficiency in teaching all of the limitations of claim 29. Therefore, the various combinations of record do not teach all elements of the claimed invention of claim 29.

Claims 37-39 depend from base claim 29, and thus inherit all limitations of claim 29. Claims 37-39 set forth features and limitations not recited by the various combinations of record. Thus, the Applicant respectfully asserts that for the above reasons claims 37-39 are patentable over the 35 U.S.C. § 103(a) rejections of record.

**Conclusion**

In view of the above, Applicant believes the pending application is in condition for allowance.

Applicant believes no additional fee is due with this response. However, if a fee is due, please charge any fees required or credit any overpayment to Deposit Account 06-2380 under Order No. 51407/P029US/10605267 during the pendency of this Application pursuant to 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Dated: June 17, 2009

**Amendment Accompanying RCE**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.8(a)(4).

Dated: June 17, 2009

Signature: 

(Joy H. Perigo)

Respectfully submitted,

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